

REMARKS

Claims 3-5, 7-11 and 13 are currently pending, wherein claim 8 has been rewritten in independent form, and claims 1 and 11 have been amended to include the subject matter of canceled claims 6 and 12. Applicants respectfully request favorable reconsideration in view of the remarks presented herein below.

Request for Withdrawal of Finality

In paragraph 2 of the Office Action ("Action"), the Examiner asserts that the amendments to claim 3 filed on April 7, 2006 "changed the meets and bounds of the claim as originally analyzed and discussed by the Examiner in the previous office action." In addition, in paragraph 8 of the Action, the Examiner asserts that Applicants' amendments necessitated the new grounds of rejection presented in the Action.

However, Applicants note that although claim 3 was amended to remove typographical and/or translation errors, and to more closely conform to U.S. patent practice, the "meets and bounds" of the claim was not changed. Original claim 3 defines an apparatus that includes extracting means, recording means, reading means, and speed converting means, and amended claim 3 defines an apparatus that includes an extracting unit, a recording unit, a reading unit, and speed converting unit. Accordingly, the meets and bounds of claim 3 was not affected by the amendment to claim 3. To the contrary, it appears that Applicants' persuasive arguments initiated the Examiner's new grounds of rejection. Therefore, the finality of the present Action is improper.

Response to Office Action

In paragraph 4 of the Action, the Examiner rejects claims 3, 4, 6, 7, and 10-13 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,648,960 to Sakazaki et al. ("Sakazaki"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102, the cited reference must teach each and every claimed element. In the present case, claims 3, 4, 6, 7, and 10-13 are not anticipated by Sakazaki for at least the reason that Sakazaki fails to disclose each and every claimed element as discussed below.

Independent claim 3 has been amended to include the subject matter of canceled claim 6. Accordingly, claim 3 now defines a program recording/reproducing apparatus for demultiplexing predetermined coded program signals out of streaming signals and recording these program signals. The apparatus includes, *inter alia*, a recording unit that records the respective program packets and a discarded packet count corresponding to the number of packets discarded between two consecutively recorded program packets, wherein the recording unit records one control packet structured in the same format as the program packet as a substitute for a discarded packet, thereby recording a discarded packet count of the packets discarded between two consecutive program packets.

Sakazaki discloses a recording/reproducing apparatus for a data packet stream that includes a data combiner 4 that combines extracted data and information relating to the number of deleted packets. For example, if the input is an MPEG-2 transport data

stream, the data combiner reconstructs the transport data stream by assigning two of the extracted data packets to five recorded data packets of a 6mm digital video tape recorder (VTR) and uses the residual bytes within the sync block to transmit the number of deleted blocks. Therefore, although Sakazaki may disclose recording information relating to the number of deleted packets, nowhere in Sakazaki is there any disclosure of recording a control packet which includes the discarded packet count in the same format as the program packet as originally recited in dependent claim 6, and now recited in claim 1. Accordingly, independent claim 1 is patentable over Sakazaki because Sakazaki fails to disclose each and every claimed element.

Independent claim 11 has been amended to include the subject matter of canceled claim 12. Accordingly, claim 3 now defines a method of recording and reproducing predetermined program signal packets from streaming multiplexed signals. The method includes, *inter alia*, recording the extracted predetermined program signal packets and a count of the number of discarded packets between each extracted packet on a recording media, wherein the discarded packet count is recorded in a control packet structured in the same format as a program product. Accordingly, independent claim 11 is not anticipated by Sakazaki for at least the reason that Sakazaki fails to disclose recording the discarded packet count in a control packet structured in the same format as a program packet. (See discussed above with respect to claim 1.)

Claims 4, 7, 10, and 13 variously depend from independent claims 1 and 11. Therefore, claims 4, 7, 10, and 13 are patentable over Sakazaki for at least those

reasons presented above with respect to claims 1 and 11. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 3, 4, 7, 10, 11, and 13 under 35 U.S.C. § 102(b).

In paragraph 6 of the Action, the Examiner rejects claim 5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakazaki. Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* of obviousness, three criteria must be met. First, there must be some motivation to modify the cited reference. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claim 3 is not rendered unpatentable in view of Sakazaki because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

In rejecting claim 5, the Examiner takes Official Notice that detecting the speed of an input signal for recording and reproduction purposes by means of time management information is notoriously well known. Therefore, the Examiner asserts that it would have been obvious to modify the system of Sakazaki "in order to specify using time management information from the input data stream to determine an output data rate." However, nowhere in the cited reference or the Action is there any evidence or suggestion of the motivation to modify the system of Sakazaki.

As discussed in § 2143.01 of the MPEP, the mere fact that individual elements were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine/modify the cited reference. Therefore, the mere fact that detecting the speed of an input signal by means of time management information maybe known in the art is not sufficient in and of itself to render claim 5 unpatentable over Sakazaki. Accordingly, absent some objective reason to modify the teachings of Sakazaki to include the use of time management information as claimed, the rejection of claim 5 is improper.

Furthermore, even if, *arguendo*, one skilled in the art were motivated to modify Sakazaki as suggested by the Examiner, the modification would still fail to render claim 5 unpatentable because the combination fails to disclose each and every claimed element. More specifically, nowhere in Sakazaki is there any disclosure or suggestion of recording the discarded packet count in a control packet as claimed. Accordingly, Applicants respectfully request reconsideration and withdrawal the rejection of claim 5 under 35 U.S.C. § 103.

In paragraph 7 of the Action, the Examiner rejects claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Sakazaki in view of MPEP-2 by Watkinson ("Watkinson"). Applicants respectfully traverse this rejection.

Again, in order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. In the present case, claims 8 and 9 are

not rendered unpatentable over the combination of Sakazaki and Watkinson because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

In rejecting claims 8 and 9, the Examiner asserts that it would have been obvious to one skilled in the art to modify Sakazaki "in order to specify the first recording packet being a stream management packet." However, the Examiner provide no motivation for such a modification other than to assert that Watkinson discloses that MPEG-2 transport streams include a management packet. As discussed above, the mere fact that individual elements were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine/modify the cited reference. Therefore, the mere fact that it is known to transmit MPEG-2 data streams with a stream management packet as the first packet is not sufficient in and of itself to render claims 8 and 9 unpatentable. Furthermore, Watkinson discloses, *arguendo*, the MPEG-2 transport stream includes a stream management packet as a first packet, not the recorded data stream as claimed. Accordingly, absent some objective reason to modify the teachings of Sakazaki to include the use of stream management packet as claimed, the rejection of claims 8 and 9 is improper. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 8 and 9 under 35 U.S.C. § 103(a).

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle

(Reg. No. 46,607) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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